

Application No.: 10/553,206

Docket No.: 5060-0102PUS1

Amendment and Response to Holding of Lack of Unity and Election of Species Requirement

REMARKS**HOLDING OF LACK OF UNITY, RESTRICTION, AND ELECTION OF SPECIES**

The Office Action alleges that Applicant must elect a single invention from among the following two inventions:

Group I, claims 1-7, drawn to a fuel cell system; and

Group II, drawn to a method of use of a fuel cell system.

The alleged reason that the inventions do not have a commonly recited special technical feature is because "the apparatus of Group I is not limited by the method steps of Group II and thus the special technical method steps of Group II are not requisite of the Apparatus of Group I."

Applicant hereby elects Group I, claims 8-14 (new claims), with traverse.

Applicant respectfully submits that this holding of lack of unity is improper for the following reasons.

Firstly, it is well settled that, under U.S. patent law, an application for a U.S. patent cannot have a claim that recites method of use limitations in an apparatus claim. A claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). See, also, *Ex parte Marco Succi and Carolina Succi*, Appeal No. 1998-2002 (available on the USPTO's e-foia website, and *In re*

Application No.: 10/553,206

Docket No.: 5060-0102PUS1

Amendment and Response to Holding of Lack of Unity and Election of Species Requirement

Peters, 1923 C.D. 291.

In view of this, the test used to determine whether the inventions are independent and distinct is improper.

Secondly, 37 CFR §1.475 governs prosecution of this National Stage (of the PCT) Application. 37 CFR §1.475 has more sections to it than 37 CFR §1.475(a), and 37 CFR §1.475(a) does not apply to the claims presented in this Application because the very next section, i.e., 37 CFR §1.475(b) sets forth an exception to the general rule or basic principle set forth in 37 CFR §1.475(a). It is the exception set forth in 37 CFR §1.475(b) that applies to this Application.

37 CFR §1.475(b), which applies to this Application, clearly, unequivocally and unmistakably states, in pertinent part, that a national stage application containing claims to different categories of invention *will be considered to have unity of invention* if the claims are drawn to only one of the following categories: (b)(4) a process and an apparatus or means specially designed for carrying out said process.

In this Application, the apparatus recited in claims 8-14 is specially designed for carrying out the process recited in claims 15-17.

Accordingly, withdrawal of the restriction requirement/lack of unity of invention holding, is respectfully requested.

Turning to the election of species requirement, Applicant hereby elects a stationary or a portable device (species 1), with traverse.

Applicant respectfully submits that this election of species requirement is improper for the following reasons:

Application No.: 10/553,206

Docket No.: 5060-0102PUS1

Amendment and Response to Holding of Lack of Unity and Election of Species Requirement

Firstly, the alleged species are stated in terms of claims (see pages 2 and 3 of the Office Action), not embodiments. This is improper because MPEP §806.04(e) clearly points out that species are definitions of inventions and that *claims are never species*.

Species are embodiments of the claimed invention. The apparatus claims are combination claims, not subcombination claims, and any election of species requirement must be made with respect to the claimed invention, which Applicant has the fundamental right to define. The Court of Customs and Patent Appeals addressed this issue and resolved it in *In re Borkowski*, 164 USPQ 642, 645 (CCPA 1970), where the court stated that "[W]hile the examiner states the requirement to be claims which 'particularly point out and distinctly claim *the invention*' (emphasis added), § 112 actually requires claims 'particularly pointing out and distinctly claiming *the subject matter which applicant regards as his invention*.'" (emphasis added) In reality, this means that applicant must particularly point out and distinctly claim the "*subject matter sought to be patented*."

In other words, as explained in the "Borkowski" decision, an Applicant is free to define what he or she regards as the invention, and it is improper for an Examiner to tell the Applicant how to claim what the Applicant regards as his invention as long as the metes and bounds of the invention are clear and definite, as they are in the claims under rejection. Moreover, it is noted that the Examiner fails to indicate that the metes and bounds of the claim are unclear.

Instead of addressing the combination claims, the Office is breaking down the claimed combination invention (system including a fuel cell, a buffer, means for dumping energy, and means for transforming energy stored in the buffer, for example) into subcombinations which are

Application No.: 10/553,206

Docket No.: 5060-0102PUS1

Amendment and Response to Holding of Lack of Unity and Election of Species Requirement

not claimed, per se, (stationary or mobile device, particular buffer, etc.), which is wholly improper.

Additionally, for an election of species to be proper, the species, *as claimed*, have to be mutually exclusive. However, claims 9-14 depend from independent system claim 8 and therefore are not mutually exclusive from the subject matter recited in claim 8. See MPEP §806.04(f)

As to the issue of undue administrative burden, the Office Action merely states that "[E]ach of the species 1-6 above represent a multitude of features and combinations [which] require undue and burdensome search . . ." Applicant respectfully submits that this rationale is based on an improper treatment of the claimed combination invention, which ignores the fact that a combination of features is being claimed in independent claims, and that the remaining apparatus claims properly depend from combination claims, and that it is incumbent on each and every Examiner to make a reasonably comprehensive search of the prior art pertaining to the claimed invention which, in this Application is not the subcombinations on which this species election requirement is made.

Accordingly, Applicant respectfully submits that (1) the holding of lack of unity of invention is improper, (2) the election of species requirement is improper, (3) both the aforementioned holding and requirement should be withdrawn, and (4) all claims should be examined on their merits.

Application No.: 10/553,206

Docket No.: 5060-0102PUS1

Amendment and Response to Holding of Lack of Unity and Election of Species Requirement

NEW CLAIMS

Applicant has canceled claims 1-7 without prejudice and added claims 8-17, which recite the invention, including methods of use, in the active voice.

CONCLUSION

In view of the foregoing claim amendments and remarks, Applicant respectfully requests that the holding of lack of unity of invention and the election of species requirement be withdrawn and that claims 8-17 be examined on their merits.

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Respectfully submitted,

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